

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:	Atty. Docket No.:	003797.01275	
Mohammed SAMJI <i>et al.</i>			
Serial No.:	10/691,841	Group Art Unit:	2162
Filed:	October 23, 2003	Examiner:	Ly, Anh
For:	System and Method for Virtual Folder Sharing Including Utilization of Static and Dynamic Lists	Confirmation No.:	6685

APPEAL BRIEF

U.S. Patent and Trademark Office
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Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This is an Appeal Brief filed in support of Appellants' May 17, 2006, Notice of Appeal. Appeal is taken from the final Office Action mailed February 17, 2006 (hereafter, "Final Office Action"), the Advisory Action mailed April 27, 2006, and the Notice of Panel Decision from Pre-Appeal Brief Review ("Notice") mailed January 29, 2007. This Appeal Brief is timely filed because Applicant has one month from the mailing date of the Notice to file a response.

Please charge any fees to our Deposit Account No. 19-0733. In addition, any extension of time necessary for acceptance of this paper is hereby requested.

REAL PARTY IN INTEREST

37 C.F.R. § 41.37(c)(1)(i)

The owner of this application, and the real party in interest, is Microsoft Corporation.

RELATED APPEALS AND INTERFERENCES

37 C.F.R. § 41.37(c)(1)(ii)

There are no related appeals or interferences.

STATUS OF CLAIMS

37 C.F.R. § 41.37(c)(1)(iii)

Claims 1-55 are pending and rejected. No claims have been canceled. Appellants hereby appeal the rejection of claims 1-55.

STATUS OF AMENDMENTS

37 C.F.R. § 41.37(c)(1)(iv)

No amendment has been filed subsequent to the Final Office Action.

SUMMARY OF CLAIMED SUBJECT MATTER

37 C.F.R. § 41.37(c)(1)(v)

The invention is generally directed to communication between users in a computer system. More specifically, the invention relates to identifying and sharing groups of items on a computer system with other users. **P. 5, ll. 7-8.**

The following summary of the claimed subject matter identifies examples of portions of the original specification and drawings at which examples of the various claim features are described or illustrated. The various claim features and the claimed subject matter may be described, discussed, and/or illustrated at other portions of the specification and/or in additional drawings not expressly identified in the summary that follows.

A summary of the claimed subject matter for each independent claim involved in this appeal follows:

Claim 1 recites a method for sharing items in a computer system between a sharer and a sharee. **P. 3, ll. 5-23.** This method includes executing on the sharer's computer a query comprising a scope and a criteria. FIG. 3 illustrates execution of a query according to embodiments of the invention, FIG. 37 illustrates defining a scope for a query according to embodiments of the invention, and FIG. 44 illustrates execution of a query with a scope and criteria that returns a dynamic list according to embodiments of the invention. **P. 3, ll. 7-10; P. 4, ll. 7-9.** A list with a plurality of referenced items is created on the sharer's computer based on the results of the query. **P. 3, l. 25 – P. 4, l. 2; P. 4, ll. 13-22.** The list is shared with the sharee such that the sharee is provided with access to the referenced items from the sharer's computer. **P. 3, l. 25 – P. 4, l. 2; P. 4, ll. 13-22.** FIGS. 42 and 46 respectively illustrate examples of sharing a static and dynamic list according to embodiments of the invention

Claim 10 recites a method for sharing items in a computer system. **P. 3, ll. 5-23.** This method includes receiving permission to access a list on the sharer's computer with referenced items, wherein the referenced items are based on the results of a query executed on the sharer's computer. **P. 3, l. 25 – P. 4, l. 2; P. 3, ll. 7-10; P. 4, ll. 7-9.** FIG. 44 illustrates execution of a query with a scope and criteria that returns a dynamic list according to embodiments of the invention. In response to receiving the permission to access the list, the list and the referenced items are accessed. **P. 4, l. 21 – P. 5, l. 2; P. 35, l. 3-7.**

Claim 17 recites computer-readable media for enabling a computer-program segment to communicate with one or more other computer-program segments. **P. 39, l. 16 – P. 40, l. 8.** This computer-readable media includes a set of computer-usable instructions that cause a request to provide access to a set of items based on the results of a query executed on the sharer's computer that are referenced in a virtual folder on the sharer's computer to be communicated to one or more other computer-program segments capable of executing said request. **P. 41, l. 9-14; P. 3, l. 25 – P. 4, l. 2; P. 9, l. 16 – P. 10, l. 2.** FIG. 4 illustrates creation of a virtual folder based on a query, according to embodiments of the invention.

Claim 24 recites a method of communicating between a sharer of a list and a sharee. **P. 3, ll. 5-23.** This method includes receiving from the sharee a call for accessing on a computer of the sharer items that are referenced on the list, wherein the list is based on the results of a query executed on the sharer's computer and stored on the sharer's computer. **P. 3, l. 25 – P. 4, l. 2; P. 3, ll. 7-10; P. 4, ll. 7-9.** Then, responsive to authorization received from the sharer, access is provided to the items. **P. 4, l. 21 – P. 5, l. 2; P. 35, l. 3-7.**

Claim 31 recites computer-readable media for enabling a sharer to share a set of items that are referenced on a list with a sharee. **P. 39, l. 16 – P. 40, l. 8; P. 3, ll. 5-23.** This computer-readable media includes a set of computer-usable instructions that allow the sharee to access the items directly through the sharer's computer. **P. 3, l. 25 – P. 4, l. 2; P. 4, ll. 13-22.** FIGS. 42 and 46 respectively illustrate examples of sharing a static and dynamic list according to embodiments of the invention. Additionally, the set of items referenced on the list are based on the results of a query executed on the sharer's computer, and the list comprises an order of the items referenced on the list. **P. 3, l. 25 – P. 4, l. 2; P. 3, ll. 7-10; P. 4, ll. 7-9; P. 3, ll. 14-16.**

FIG. 44 illustrates execution of a query with a scope and criteria that returns a dynamic list according to embodiments of the invention.

Claim 36 recites a method for sharing items in a computer system between a sharer and a sharee. **P. 3, ll. 5-23.** This method includes executing on the sharer's computer a query comprising a scope and a criteria. FIG. 3 illustrates execution of a query according to embodiments of the invention, FIG. 37 illustrates defining a scope for a query according to embodiments of the invention, and FIG. 44 illustrates execution of a query with a scope and criteria that returns a dynamic list according to embodiments of the invention. **P. 3, ll. 7-10; P. 4, ll. 7-9.** A virtual folder is created on the sharer's computer with a plurality of referenced items based on the results of the query. **P. 3, l. 25 – P. 4, l. 2; P. 9, l. 16 – P. 10, l. 2.** FIG. 4 illustrates creation of a virtual folder based on a query, according to embodiments of the invention. The virtual folder is shared with the sharee such that the sharee is provided with access to the referenced items from the sharer's computer. **P. 3, l. 25 – P. 4, l. 2; P. 9, l. 16 – P. 10, l. 2.** FIGS. 42 and 46 respectively illustrate examples of sharing a static and dynamic list according to embodiments of the invention

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

37 C.F.R. § 41.37(c)(1)(vi)

Claims 1-2, 10-11, 17-18, 24-25, 31-32, 36-37, and 43-55 stand rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent Appl. Publ. No. US 2004/0148434 A1 to Matsubara ("Matsubara") in view of "A Case for Associative Peer to Peer Overlays" of Cohen, et al. ("Cohen").

Claims 3-4, 8-9, 12, 15-16, 19, 22-23, 26, 29-30, 33, and 38-39 stand rejected under 35 U.S.C. § 103(a) as being obvious over Matsubara in view of Cohen, and further in view of U.S. Patent Appl. Publ. No. US 2003/0225796 A1 to Matsubara ("M'796").

Claims 5-7, 13-14, 20-21, 27-28, 34-35, and 40-42 stand rejected under 35 U.S.C. § 103(a) as being obvious over Matsubara in view of Cohen, and further in view of U.S. Patent Appl. Publ. No. US 2003/0236847 A1 to Benowitz et al. ("Benowitz").

ARGUMENT

37 C.F.R. § 41.37(c)(1)(vii)

Arguments Presented in Pre-Appeal Request for Review

During the Pre-Appeal process, Appellants noted the following errors, which Appellants believe represent the clearest reasons why the rejections should be overturned and the claims allowed. The specific errors relied upon in the Pre-Appeal Brief Request for Review include the following:

- The Office made a clear legal and/or factual error in its analysis of the Matsubara and Cohen references. As argued in the Request for Reconsideration dated April 17, 2006 (pp. 2-3), neither Matsubara nor Cohen teaches or suggests sharing items based on the results of a query as claimed.
- The Office made a clear legal and/or factual error in its analysis of the Benowitz reference. As argued in the Request for Reconsideration dated April 17, 2006 (pp. 3-4), Benowitz does not teach dynamic lists as claimed.

Notwithstanding, Appellants provide the following substantive arguments in support of this appeal, which incorporate the arguments cited above, and also presents additional issues that merit review.

1. Claims 1-2, 10-11, 17-18, 24-25, 31-32, 36-37, and 43-55 are Patentable in View of Matsubara and Cohen.

Independent Claims 1, 10, 17, 24, 31, and 36

Claim 1 recites a method comprising executing a query on the sharer's computer, creating a list of items on the sharer's computer "based on the results of said query" and sharing the list with a sharee such that the sharee is provided with access to the referenced items from the sharer's computer. Matsubara and Cohen each disclose peer-to-peer (P2P) file-sharing networks, either having a centralized index and architecture (*e.g.*, Napster) or having a completely decentralized architecture (*e.g.*, Gnutella). Matsubara, paragraphs 0030, 0055. Cohen, Abstract; Introduction, page 95. In either the Matsubara or Cohen system, the sharee may query the index (stored either on the central server or on the sharer's computer) to discover what files have

already been shared and gain access to those files. However, in these systems, the sharing of the files by the sharer is not “based on the results of said query,” as recited in claim 1. In Matsubara and Cohen, determining the list of files to be shared by the sharer has nothing to do with the query. Rather, the sharers in Matsubara and Cohen first designate one or more items to share, after which the sharee issues a query to search for those already shared items. Thus, neither Matsubara, nor Cohen, nor the combination of the two, teaches or suggests sharing items “based on the results of said query,” as recited in claim 1.

Since each independent claim in the present application (1, 10, 17, 24, 31, and 36) similarly recites sharing items based on a query, each independent claim is similarly not obvious over the alleged combination of Matsubara and Cohen. Accordingly, Applicants submit that independent claims 1, 10, 17, 24, 31, and 26, and all of their respective dependent claims, are allowable under 35 U.S.C. § 103(a) over the cited references for at least these reasons.

2. Claims 3-4, 8-9, 12, 15-16, 19, 22-23, 26, 29-30, 33, and 38-39 are Patentable in View of Matsubara, Cohen, and M’796.

As discussed above, the proposed combination of Matsubara and Cohen fails to teach or suggest sharing items based on the results of a query executed on the sharer’s computer. M’796 fails to cure the deficiencies of the proposed combination of Matsubara and Cohen in that M’796 also does not teach or suggest sharing items based on the results of a query executed on the sharer’s computer. Claims 3-4, 8-9, 12, 15-16, 19, 22-23, 26, 29-30, 33, and 38-39, which depend respectively from claims 1, 10, 17, 24, 31, and 36, are allowable over the alleged combination of Matsubara, Cohen, and M’796 for the reasons stated above concerning their respective base claims, and further in view of the novel and non-obvious features recited therein.

3. Claims 5-7, 13-14, 20-21, 27-28, 34-35, and 40-42 are Patentable in View of Matsubara, Cohen, and Benowitz.

As discussed above, the proposed combination of Matsubara and Cohen fails to teach or suggest sharing items based on the results of a query executed on the sharer’s computer. Benowitz also fails to cure this deficiency of the proposed combination of Matsubara and Cohen. Thus, claims 5-7, 13-14, 20-21, 27-28, 34-35, and 40-42, are allowable over the alleged

combination of Matsubara, Cohen, and Benowitz for the reasons stated above concerning their respective base claims, and further in view of the novel and non-obvious features recited therein.

Dependent Claims 5, 13, 20, and 27

Claim 5, for example, recites “wherein the list is a dynamic list.” Neither Matsubara, Cohen, nor Benowitz, teaches or suggests using a dynamic list to share items. Indeed none of these references even contains the term “dynamic list” or discloses a similar concept. The Final Office Action correctly acknowledges that that Matsubara and Cohen do not teach a dynamic list, but then asserts that Benowitz teaches dynamic lists because “Benowitz teaches email address list or address book or dynamic email address (a non-file item list).” Final Office Action, page 21. Applicants disagree that the dynamic email addresses of Benowitz teach or suggest a “dynamic list,” as recited by claim 5. Benowitz explains dynamic email addresses in paragraph [0018]:

[0018] In one particular embodiment, the authorization code is at least part of the email address of the recipient. Thus, for example, the recipient may provide authorization codes to various potential senders with instructions to insert the code into the email address of the recipient. As such, incoming email messages for a particular recipient could include a variable portion to contain an authorization code and a static portion which includes the recipient's common email address to allow the email system of the recipient to properly route the email message to the intended recipient. This creates a dynamic email address for the recipient that can be altered at any time by the recipient to effectively control incoming email. This is a particularly useful way to control incoming email since embedding the code in the actual email address of the user allows CAS to be used with all existing email systems. The authorization codes may be transferred, conveyed or provided to a potential sender via various methods.

Thus, Benowitz's dynamic email addresses are an anti-spam technique which involves embedding an authorization code into a recipient's email address. The claimed “dynamic lists” of the present application are an entirely different concept, and are discussed at length in the specification. For example:

If any items in the dynamic list have their properties changed such that they no longer meet the criteria of the dynamic list, then these items are appropriately re-permissioned. In the same way, if any items that do not belong to the dynamic list change such that they fall into the scope and meet the criteria of the dynamic list, they are also re-permissioned to grant access to the users with which the dynamic list is shared.

Specification, page 4, line 22 to page 5, line 2. Thus, since neither Matsubara, Cohen, or Benowitz teach or suggest a “dynamic list,” as recited in claim 5, this claim is not obvious under 35 U.S.C. § 103(a) in view of the cited references.

Claims 13, 20, and 27 each recite either “wherein the list is a dynamic list” (claims 13 and 27) or “wherein the virtual folder comprises a dynamic list” (claim 20), and thus are also not obvious under 35 U.S.C. § 103(a) in view of Matsubara, Cohen, and Benowitz.

Dependent Claims 6, 14, 21, and 28

Claims 6, 14, 21, and 28 further clarify the differences between the dynamic lists recited in claims 5, 13, 20, and 28, and the dynamic email addresses relied upon by the Final Office Action. For example, claim 6 recites, “wherein when an item that is on the dynamic list has a property change such that it no longer meets the criteria of the dynamic list, the sharee is no longer provided with access to the item.” As discussed above, Benowitz’s dynamic email addresses do not refer to list of items to be shared, nor do they even relate to item sharing in general. Moreover, Benowitz’s dynamic email addresses do not have an associated criteria, as do the recited dynamic lists. Therefore, Benowitz does not teach or suggest “wherein when an item that is on the dynamic list has a property change such that it no longer meets the criteria of the dynamic list, the sharee is no longer provided with access to the item,” as recited in claim 6. Accordingly, Applicants submit that claim 6 is not obvious in view of the proposed combination of Matsubara, Cohen, and Benowitz.

Claims 14, 21, and 28 recite similar features relating to changing a sharee’s access permissions based on a change in the properties of the items in the dynamic list. Thus, claims 14, 21, and 28 are also not obvious under 35 U.S.C. § 103(a) in view of the cited references.

Dependent Claims 34 and 35

In addition, claim 34 recites “wherein when the sharer attempts to provide access to an item for which access may not be available, a notification is provided to the sharer that the sharee may not be able to access the item.” The Final Office Action incorrectly states on page 23 that “Claim 34 is essentially the same as claim 13...” Since this statement is clearly incorrect, and since Benowitz does not teach or suggest providing a notification to the sharer after an attempt to share an item that the sharee may not be able to access the item, the Applicants submit that the Examiner has failed to present a *prima facie* case of obviousness with respect to claim 34.

Claim 35 recites, “wherein the type of access that is provided to the items may be one of read or read-write.” As with claim 34, the Final Office Action incorrectly states on page 23 that “Claim 35 is essentially the same as claim 14...” Since this statement is clearly incorrect, and since Benowitz does not teach or suggest sharing items with read or read-write access, the Applicants submit that the Examiner has also failed to present a *prima facie* case of obviousness with respect to claim 35.

CONCLUSION

For all of the foregoing reasons, Appellant respectfully submits that the final rejection of claims 1-48 is improper and should be reversed.

Respectfully submitted,
BANNER & WITCOFF, LTD.

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By: /Ross Dannenberg/
Ross A. Dannenberg
Registration No. 49,024

1100 13th Street, N.W.
Washington, D.C. 20005
Tel: (202) 824-3000
Fax: (202) 824-3001

CLAIMS APPENDIX
37 C.F.R. § 41.37(c)(1)(viii)

Claims involved in the appeal:

1. A method for sharing items in a computer system between a sharer and a sharee comprising:

executing on the sharer's computer a query comprising a scope and a criteria;

creating on the sharer's computer a list with a plurality of referenced items based on the results of said query; and

sharing the list with a sharee such that the sharee is provided with access to the referenced items from the sharer's computer.

2. The method of Claim 1, wherein the list is a static list.

3. The method of Claim 2, wherein when the sharer removes items from the list, the sharee is no longer provided with access to the items.

4. The method of Claim 2, wherein when items are added to the list, the sharee is provided with access to the added items.

5. The method of Claim 1, wherein the list is a dynamic list with a scope and set of criteria for the referenced items.

6. The method of Claim 5, wherein when an item that is on the dynamic list has a property change such that it no longer meets the criteria of the dynamic list, the sharee is no longer provided with access to the item.

7. The method of Claim 5, wherein when an item that was not previously on the dynamic list has a property change such that it meets the criteria of the dynamic list, the sharee is provided with access to the item.

8. The method of Claim 1, wherein when the sharer is unable to grant access to the sharee for an item, a notification is provided to the sharer.

9. The method of Claim 1, wherein the sharer is able to limit the type of access that the sharee has to the items.

10. A method for sharing items on a computer system comprising:
receiving permission to access a list on the sharer's computer with referenced items, wherein the referenced items are based on the results of a query executed on the sharer's computer; and
in response to receiving the permission to access the list, accessing the list and the referenced items.

11. The method of Claim 10, wherein the list is a static list that is formed as a virtual folder.

12. The method of Claim 11, wherein when an item is added or removed from the list, the permission to access the item is correspondingly added or removed.

13. The method of Claim 10, wherein the list is a dynamic list that is formed as a virtual folder with a set of criteria for the referenced items.

14. The method of Claim 13, wherein when items have changes to their properties such that they meet or no longer meet the criteria of the dynamic list, the permission to access the item is correspondingly added or removed.

15. The method of Claim 10, wherein when access to an item is unavailable, a notification is provided.

16. The method of Claim 10, wherein the permission to access the list specifies the type of access that is available for the items.

17. One or more computer-readable media for enabling a computer-program segment to communicate with one or more other computer-program segments, said media comprising:

a set of computer-usable instructions that cause a request to provide access to a set of items based on the results of a query executed on the sharer's computer that are referenced in a virtual folder on the sharer's computer to be communicated to one or more other computer-program segments capable of executing said request.

18. The media of Claim 17, wherein the virtual folder comprises a static list.
19. The media of Claim 18, wherein when items are added or removed from the list, permission for the access of the items is correspondingly added or removed.
20. The media of Claim 17, wherein the virtual folder comprises a dynamic list with a set of criteria for the referenced items.
21. The media of Claim 20, wherein when an item has a property change such that it meets or no longer meets the criteria of the list, the permission to access the item is correspondingly added or removed.
22. The media of Claim 17, wherein when access to an item is unavailable, a notification is provided.
23. The media of Claim 17, wherein the access to the items may be limited to be one of read/write or read only.
24. A method of communicating between a sharer of a list and a sharee comprising:
receiving from the sharee a call for accessing on a computer of the sharer items that are referenced on the list, wherein the list is based on the results of a query executed on the sharer's computer and stored on the sharer's computer; and

responsive to authorization received from the sharer, providing the sharee access to the items.

25. The method of Claim 24, wherein the list is a static list.

26. The method of Claim 25, wherein as items are added or removed from the list, the access to the items is correspondingly allowed or denied.

27. The method of Claim 24, wherein the list is a dynamic list with a set of criteria for the items.

28. The method of Claim 27, wherein as the properties of items change such that the items meet or no longer meet the criteria for the list, the items are correspondingly added or removed from the list.

29. The method of Claim 24, wherein when access may be unavailable to an item that is on the list when the list is shared, a notification is provided to the sharer.

30. The method of Claim 24, wherein the sharer is able to limit the type of access to the items.

31. One or more computer-readable media for enabling a sharer to share a set of items that are referenced on a list with a sharee comprising:

a set of computer-usable instructions that allow the sharee to access the items directly through the sharer's computer,

wherein the set of item referenced on the list are based on the results of a query executed on the sharer's computer, and wherein the list comprises an order of the items referenced on the list.

32. The media of Claim 31, wherein the list is one of a static list and a dynamic list.

33. The media of Claim 31, wherein as items are added or removed from the list, the sharee's permission to access the items is correspondingly added or removed.

34. The media of Claim 31, wherein when the sharer attempts to provide access to an item for which access may not be available, a notification is provided to the sharer that the sharee may not be able to access the item.

35. The media of Claim 31, wherein the type of access that is provided to the items may be one of read or read-write.

36. A method for sharing items in a computer system between a sharer and a sharee comprising:

executing on the sharer's computer a query comprising a scope and a criteria;

creating on the sharer's computer a virtual folder with a plurality of referenced items based on the results of said query; and

sharing the virtual folder with a sharee such that the sharee is provided with access to the referenced items from the sharer's computer.

37. The method of Claim 36, wherein the virtual folder is a static virtual folder.

38. The method of Claim 37, wherein when the sharer removes items from the virtual folder, the sharee is no longer provided with access to the items.

39. The method of Claim 37, wherein when items are added to the virtual folder, the sharee is provided with access to the added items.

40. The method of Claim 36, wherein the virtual folder is a dynamic virtual folder with a scope and set of criteria for the referenced items.

41. The method of Claim 40, wherein when an item that is in the dynamic virtual folder has a property change such that it no longer meets the criteria of the dynamic virtual folder, the sharee is no longer provided with access to the item.

42. The method of Claim 40, wherein when an item that was not previously on the dynamic virtual folder has a property change such that it meets the criteria of the dynamic virtual folder, the sharee is provided with access to the item.

43. The method of claim 1, wherein the creating step comprises defining within the list an order of the plurality of referenced items.

44. The method of claim 1, wherein the creating step comprises defining within the list an annotation corresponding to at least one of the plurality of referenced items.

45. The method of claim 10, wherein the list comprises a predefined order of the referenced items.

46. The method of claim 10, wherein the list comprises an annotation corresponding to at least one of the referenced items.

47. The method of claim 24, wherein the list comprises a predefined order of the referenced items.

48. The method of claim 24, wherein the list comprises an annotation corresponding to at least one of the referenced items.

49. The method of claim 1, wherein the sharee is provided with remote access to the referenced items from another computer.

50. The method of claim 10, wherein accessing the list and the referenced items is performed remotely from another computer.

51. The computer readable medium of claim 17, wherein the request to provide access comprises a request to provide remote access from another computer.

52. The method of claim 24, wherein providing the sharee access to the items comprises providing the sharee remote access to the items.

53. The method of claim 24, wherein the receiving step comprises receiving the call via an API.

54. The one or more computer readable media of claim 31, wherein the set of computer-usable instructions allow the sharee to remotely access the items.

55. The method of claim 36, wherein in the sharing step the sharee is provided with remote access to the referenced items.

EVIDENCE APPENDIX
37 C.F.R. § 41.37(c)(1)(ix)

NONE.

RELATED PROCEEDINGS APPENDIX
37 C.F.R. § 41.37(c)(1)(x)

NONE.